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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,968	12/03/2004	Hideo Harada	37251	3138
116	7590	11/21/2006	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			FOX, BRYAN J	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/516,968

Applicant(s)

HARADA ET AL

Examiner

Bryan J. Fox

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 8, 2006 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4-8, 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlish in view of Imai (US006389267B1).

Regarding **claim 4**, Pawlish et al disclose a communication device that includes a first housing portion 11 and a second housing portion 12 hinged together with a speaker in the first housing portion and a microphone on the second housing portion (see column 2, lines 28-44 and figure 1), which reads on the claimed, "foldable mobile phone in which a first case having a transmission microphone and a second case having a receiver are coupled to each other so as to be opened and closed freely," and, "a speaker, which is provided at a portion of the second case which is exposed when the first case and the second case are closed." The system includes volume up and down controls, which reads on the claimed, "volume variable unit which adjusts a sounding volume of the speaker to a level substantially same as a sounding volume of the receiver." When the radio is in the open position, the volume of the speaker port is set to a different level than in the open position (see column 2, line 65 – column 3, lines 42), which reads on the claimed, "switching unit which switches setting functions so that a first function for communicating by using the transmission microphone and the receiver is set in a case of communicating at a state that the first case and the second case are opened to each other, and a second function for communicating by using the transmission microphone and the speaker is set such that the sounding volume of the receiver by the volume variable unit in a case of communicating at a state that the first case and the second case are closed to each other." A position switch used for determining the relative position of the housing portions 11 and 12 and coupled to the controller in order to provide automatic control features relating to the positions of the housing portions 11 and 12. When the radio is in the open position, a different

Art Unit: 2617

configuration is used than when the phone is in a closed positions (see column 2, line 65 – column 3, line 42), which reads on the claimed, “the switching unit switches to the first function when the first case and the second case are opened to each other in a state that the second function is set.” Pawlish et al fail to expressly disclose a first button which has a function of a first communication starting operation unit and a second button having a function of a second communication starting operation unit.

In a similar field of endeavor, Imai discloses a system where when a call arrives and the second key operation section 8 is operated, the first speech transmitting and receiving unit is set to be inactive and the second speech transmitting and receiving unit is set to an active state. On the other hand, when the first key operation section 5 is operated without operation of the second key operation section 8 in the step S103, the speech communication is started in the states just as it is (see column 6, lines 16-26), which reads on the claimed, “first button, which has a function of a first communication starting operation unit, and provided at a portion which is not exposed when the first case and the second case are closed but exposed in a opened state of the first case and the second case; a second button having a function of a second communication starting operation unit and provided at a portion which is exposed when the first case and the second case are closed.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Pawlish et al with Imai to include the above buttons for choosing

the communication section in order to allow the user to choose the communication state.

Regarding **claim 5**, Pawlish et al disclose a communication device that includes a first housing portion 11 and a second housing portion 12 hinged together with a speaker in the first housing portion and a microphone on the second housing portion (see column 2, lines 28-44 and figure 1), which reads on the claimed, "foldable mobile phone in which a first case having a transmission microphone and a second case having a receiver are coupled to each other so as to be opened and closed freely," and, "a speaker, which is provided at a portion of the second case which is exposed when the first case and the second case are closed." The system includes volume up and down controls, which reads on the claimed, "volume variable unit which adjusts a sounding volume of the speaker to a level substantially same as a sounding volume of the receiver." When the radio is in the open position, the volume of the speaker port is set to a different level than in the open position (see column 2, line 65 – column 3, lines 42), which reads on the claimed, "switching unit which switches setting functions so that a first function for communicating by using the transmission microphone and the receiver is set in a case of communicating at a state that the first case and the second case are opened to each other, and a second function for communicating by using the transmission microphone and the speaker is set such that the sounding volume of the receiver by the volume variable unit in a case of communicating at a state that the first case and the second case are closed to each other." A position switch used for determining the relative position of the housing portions 11 and 12 and coupled to the

Art Unit: 2617

controller in order to provide automatic control features relating to the positions of the housing portions 11 and 12. When the radio is in the open position, a different configuration is used than when the phone is in a closed positions (see column 2, line 65 – column 3, line 42), which reads on the claimed, “the switching unit switches to the second function when the first case and the second case are closed to each other in a state that the first function is set.” Pawlish et al fail to expressly disclose a first button which has a function of a first communication starting operation unit and a second button having a function of a second communication starting operation unit.

In a similar field of endeavor, Imai discloses a system where when a call arrives and the second key operation section 8 is operated, the first speech transmitting and receiving unit is set to be inactive and the second speech transmitting and receiving unit is set to an active state. On the other hand, when the first key operation section 5 is operated without operation of the second key operation section 8 in the step S103, the speech communication is started in the states just as it is (see column 6, lines 16-26), which reads on the claimed, “first button, which has a function of a first communication starting operation unit, and provided at a portion which is not exposed when the first case and the second case are closed but exposed in a opened state of the first case and the second case; a second button having a function of a second communication starting operation unit and provided at a portion which is exposed when the first case and the second case are closed.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Pawlish et al with Imai to include the above buttons for choosing the communication section in order to allow the user to choose the communication state.

Claims 6, 7, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlish in view of Imai as applied to claim 2 above, and further in view of Ishinabe et al (US005600655A).

Regarding **claim 6**, the combination of Pawlish and Imai fails to expressly disclose the second button has a function of a first communication terminating operation unit for terminating the communication when the second button is operated during communication.

In a similar field of endeavor, Ishinabe et al disclose a communication key used for start/end of communication (see column 2, lines 57-67 and figure 2).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Pawlish and Imai with Ishinabe et al to include the above key that starts and ends communication in order to save space in the keypad.

Regarding **claim 7**, as applied to claim 6, the above combination of Pawlish, Imai and Ishinabe et al discloses continuously operating the second button for a predetermined time period, wherein if the button is pressed at all the operation would

Art Unit: 2617

read on the continuously operating for a predetermined time period wherein the time period is small.

Regarding **claim 10**, the combination of Pawlish and Imai fails to expressly disclose the second button has a function of a first communication terminating operation unit for terminating the communication when the second button is operated during communication.

In a similar field of endeavor, Ishinabe et al disclose a communication key used for start/end of communication (see column 2, lines 57-67 and figure 2).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Pawlish and Imai with Ishinabe et al to include the above key that starts and ends communication in order to save space in the keypad.

Regarding **claim 11**, as applied to claim 6, the above combination of Pawlish, Imai and Ishinabe et al discloses continuously operating the second button for a predetermined time period, wherein if the button is pressed at all the operation would read on the continuously operating for a predetermined time period wherein the time period is small.

Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlish in view of Imai as applied to claim 2 above, and further in view of what was well known in the art (see MPEP 2144.03).

Regarding **claim 8**, the combination of Pawlish and Imai suggests a recessed button 14 at an outer face (see figure 1). The combination of Pawlish and Imai fails to expressly disclose the second button is disposed within a recess portion formed at an outer face of at least one of the first case and second case.

The examiner takes official notice that a button disposed within a recess portion formed at an outer face of at least one of the first case and second case was well known to a person of ordinary skill in the art at the time of the invention.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Pawlish and Imai such that the second button is disposed within a recess portion formed at an outer face of at least one of the first case and second case in order to lessen the likelihood of accidentally operating the button.

Regarding **claim 12**, the combination of Pawlish and Imai suggests a recessed button 14 at an outer face (see figure 1). The combination of Pawlish and Imai fails to expressly disclose the second button is disposed within a recess portion formed at an outer face of at least one of the first case and second case.

The examiner takes official notice that a button disposed within a recess portion formed at an outer face of at least one of the first case and second case was well known to a person of ordinary skill in the art at the time of the invention.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Pawlish and Imai such that the second button is disposed within a recess portion formed at an outer face of at least one of the first

Art Unit: 2617

case and second case in order to lessen the likelihood of accidentally operating the button.

Response to Arguments

Applicant's arguments filed September 8, 2006 have been fully considered but they are not persuasive.

The Applicant argues the combination of Pawlish and Imai fails to disclose a volume variable unit which adjusts a sounding volume of the speaker to a level substantially same as a sounding volume of the receiver. The Examiner respectfully disagrees. The system includes volume up and down controls, which reads on the claimed, "volume variable unit which adjusts a sounding volume of the speaker to a level substantially same as a sounding volume of the receiver."

The Applicant argues that Pawlish does not disclose a foldable mobile phone comprising a first case having a transmission microphone and a second case having a receiver and a speaker, which is exposed when the first case and the second case are closed. The Examiner respectfully disagrees. As recited in the rejection above, Pawlish et al disclose a communication device that includes a first housing portion 11 and a second housing portion 12 hinged together with a speaker in the first housing portion and a microphone on the second housing portion (see column 2, lines 28-44 and figure 1), which reads on the claimed language.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the receiver in the present application is another speaker) are not recited in the

Art Unit: 2617

rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the fact that the receiver has a volume does not require an external speaker as stated by the Applicant. The receiver is read to be the circuitry receiving the signals and delivering the audio to the speaker.

The Applicant argues the combination of Pawlish and Imai fails to disclose a switching unit, which switches setting functions so that a first function for communicating by using the transmission microphone and the receiver is set in a case of starting communicating by operating the first button, and a second function for communicating by using the transmission microphone and the speaker is set such that the sounding volume of the speaker is adjusted to the level substantially same as the sounding volume of the receiver by the volume variable unit in a case of starting communicating by operating the second button and wherein the switching unit switches to the first function when the first case and the second case are opened to each other in a state that the second function is set or wherein the switching unit switches to the second function when the first case and the second case are closed to each other in a state that the first communication function is set. The Examiner respectfully disagrees. As stated in the rejection of claims 4 and 5 above, Pawlish discloses when the radio is in the open position, the volume of the speaker port is set to a different level than in the open position (see column 2, line 65 – column 3, lines 42). A position switch used for determining the relative position of the housing portions 11 and 12 and coupled to the controller in order to provide automatic control features relating to the positions of the

Art Unit: 2617

housing portions 11 and 12. When the radio is in the open position, a different configuration is used than when the phone is in a closed positions (see column 2, line 65 – column 3, line 42).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J. Fox whose telephone number is (571) 272-7908. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Bryan Fox
November 16, 2006


CHARLES APPIAH
PRIMARY EXAMINER